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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,196	12/21/2001	Thomas A. Love	000105-0001	8436

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EXAMINER

THOMPSON, CAMIE S

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 07/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/026,196	LOVE, THOMAS A.
	Examiner	Art Unit
	Camie S Thompson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 14 May 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 and 24-33 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 28-31 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-22,24-27,32 and 33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
- 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other: _____

DETAILED ACTION

1. Applicant's amendment and accompanying remarks filed on May 14, 2003 have been acknowledged.
2. Examiner acknowledges amended claims 1, 4, 10, 12 and 24.
3. Examiner acknowledges cancelled claim 23.
4. The rejection of claim 12 under 35 U.S.C. 112, second paragraph is withdrawn due to applicant's amended claim 12.

Claim 4 is withdrawn from prosecution.

Original claims 1-27 were directed towards a high-temperature rigid fiberboard. Claim 4 is written in Amendment B as directed towards a decorative cordless light emission element display apparatus.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 4 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. The restriction between Groups I and III is withdrawn due to applicant's argument.

Claims 32 and 33 will be examined along with claims 1-3, 5-22 and 24-27.

6. The rejection of claims 1-9 and 23-27 under 35 U.S.C. 102(b) as being anticipated by Francis et al., U.S. Patent Number 5,723,226 is withdrawn due to applicant's amendment and argument.

7. The rejection of claims 10-22 under 35 U.S.C. 103(a) as being unpatentable over Shannon, U.S. Patent Number 3,661,663 in view of Hart, U.S. Patent Number 6,043,172 is withdrawn. Shannon is reapplyed alone.

Priority

8. The serial number and the filing date of the provisional application listed in the first sentence on page 1 is inconsistent with US Patent and Trademark records. Applicant is requested to clarify the serial number and the filing date.

Oath/Declaration

9. The executed declaration has a serial number and filing date of the provisional application that is inconsistent with US Patent and Trademark records. Applicant is requested to provide a substitute declaration containing the corrected priority information.

Claim Objections

10. Claim 15 is objected to because of the following informalities: The word "of" is missing from the phrase "consisting of". Examiner suggests added the word "of" after the word "consisting". Appropriate correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-3, 5-22, 24-27 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Shannon, U.S. Patent Number 3,661,663.

Shannon discloses an insulation material used as a pressed fiberboard wherein the fibrous material includes alumina silicate fibers and mineral wool and the fiber content is greater than any other solid ingredient in the fiberboard as per instant claims 1, 10 and 32 (see Example 13, column 5, line 65- column 6, line 8 and Example 7). The reference also discloses that the fibers can be grouped together as per instant claims 10 and 12 (see column 1, lines 39-40). Although Example 13 of the reference discloses using organic binders, the reference discloses a preferred embodiment of using inorganic binders. Shannon also discloses that the body of fibers is bonded together with potassium silicate as per instant claims 10-11 and 13-15 (see column 1, lines 25-65). In addition, Shannon discloses using bentonite clay as filler material as per instant claims 16-17 (see column 2, lines 46-75). Examples 6 and 8 of the Shannon reference disclose that the fiber weight of the fiberboard is about 75%, 7% sodium silicate binder and about 15% magnesium silicate filler as per instant claims 18-22 and 32. The process limitation of providing fiberation, forming a mat, accumulating layers, heating, pressing and drying and the additional of further material are not given any patentable weight in a product claim. Claims 1-3, 5-9 and 24-²³ 27 are product-by-process claims. Even though product-by-process claims are limited and

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defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process. See MPEP 2113.

13. Claims 10-22 and 32-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Vandermeer, U.S. Patent 5,945,049.

Vandermeer discloses a pressed, ceramic fiberboard made from bonded ceramic fibers wherein the fibers are aluminosilicate or mineral wool as per instant claims 10-12 and 32 (see column 1, lines 30-56, column 2, lines 58-65 and column 3, lines 46-56). Vandermeer also discloses using an inorganic binder such as silica sols to bond the ceramic fibers together as per instant claims 13-15 and 32 (see column 1, line 60-column 2, line 11). The reference also discloses that clays such as mullite and kyanite are used as fillers in the fiberboard as per instant claims 16-17 and 32 (see column 3, lines 58-68). Additionally, Vandermeer discloses that the fiberboard comprises a ceramic fiber in the amount of 62% to about 96% by weight based on total weight of the fiberboard, binder in the amount of 2% to about 30% by weight based on the total weight of the fiberboard and a filler in the amount of up to 1% by weight based on the total weight of the fiberboard as per instant claims 18-22 and 32 (see column 2, lines 10-55 and column 4, lines 50-65).

Response to Arguments

14. Applicant's arguments filed May 14, 2003 have been fully considered but they are not persuasive. Applicant states in the amendment that claim 15 has been amended. However, it has

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not. Applicant argues that the Vandermeer reference does not claim or suggest instant claims 10-

16. Applicant argues that the process in the Vandermeer reference uses off-gassing and surface processing. The process in which the fiberboard is formed is not given any patentable weight. Applicant's method and Vandermeer's method both yield the same product. The determination of patentability is based on the product itself and the method. Process limitations in claims lend no patentable weight to the claims.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Camie S. Thompson whose telephone number is (703) 305-4488. The examiner can normally be reached on Monday through Friday from 7:30 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly, can be reached at (703) 308-0449. The fax phone numbers for the Group are (703) 872-9310 {before finals} and (703) 872-9311 {after finals}.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



MARIE YAMNITZKY
PRIMARY EXAMINER

